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EXAMINER

LOCKER, HOWARD J

ART UNIT	PAPER NUMBER
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1661

DATE MAILED: 05/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/238742

Applicant(s)

Meillard

Examiner

Locker, Howard J.

Group Art Unit

1661

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE Three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on April 01, 2005
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ ~~Claim(s)~~ The claim is ~~is~~ pending in the application.
- ☐ Of the above claim(s) is/are withdrawn from consideration.
- ☐ Claim(s) is/are allowed.
- ☒ ~~Claim(s)~~ The claim is ~~is~~ rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☒ Other Request for Information

37 CFR 1.105

Office Action Summary

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 (the claim) is rejected under 35 U.S.C. 102(b) as the instant plant was described in the following printed publication more than one year prior to the date of application for Plant Patent (January 28, 1999) in the United States:

QZ PBR 970101 (published on April 15, 1997); taken in view of the admission that "*Plants of the 'Meinussian' variety were made available to the public in France on May 20, 1996*" as stated at page 4 of applicant's April 7, 2004 response.

(This rejection was previously set forth in paragraph 1 of the Office action mailed December 02, 2004.). Applicant's arguments (filed April 1, 2005) have been considered but are not found persuasive.

The above referenced published application constitutes a "printed publication" under 35 U.S.C. 102 because it was accessible to persons concerned with the art to which the document relates. See *In re Wyer*, 655 F.2d 221, 226; 210 USPQ 790, 794 (CCPA 1981). See also MPEP Section 2128.

For example, UPOV publishes the application number, grant number, date of publication, species of plant, and variety denomination for PBR certificates, and copies of the grant and application are obtainable through the Plant Variety Rights Journal. Plant varieties are also entered in the Register of Community Plant Variety Rights and Register of Applications for Community Plant Variety rights, both of which are open to

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the public. Thus, information regarding the claimed cultivar, in the form of the publication noted above, was readily available to interested persons of ordinary skill in the art.

A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the printed publication, combined with knowledge in the prior art, would have enabled one of ordinary skill in the art to reproduce the claimed plant, and said printed publication was published more than one year prior to the date of application in the United States (*In re LeGrice*, 301, f.2d 929, 133 USPQ 365 (CCPA 1962)). If one skilled in the art could have reproduced the plant from a publicly available source, then the publication describing the plant would have an enabling disclosure. See *Ex Parte Thomson*, 24 USPQ 2d, 1618, 1620, (Bd. Pat. App. & Inter. 1992) ("The issue is not whether the [claimed] cultivar Siokora was on public use or sale in the United States but, rather, whether Siokora seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the Siokora cultivar disclosed in the cited publications."). See also MPEP 2121.03.

It has been determined (and conceded by applicant) that the above publicly available publication discloses the claimed plant variety and it has been conceded by applicant that said claimed variety was made available to the public in France more than one year prior to the filing date of the subject application for United States Plant Patent.

As such, the published application, combined with the knowledge in the prior art, would have enabled one of ordinary skill in the art to reproduce the claimed plant.

By way of explanation, information regarding the claimed variety, in the form of the publication noted above, was readily available to interested persons of ordinary skill in the art. A publication relied upon as prior art under 35 U.S.C. 102(b) must be enabling. The text of the relied upon publication standing alone would not have enabled one skilled in the art to practice the claimed invention. When a claim is drawn to a plant, the reference, combined with knowledge in the prior art, must enable one of ordinary skill in the art to reproduce the plant. The prior sale more than one year prior to the filing date of the instant application enables the referenced published document because the disclosed cultivar could have been propagated from publicly available materials, and one skilled in the art would have the knowledge of how to do so, given the notoriety of various methods of asexual propagation, in the Genus *Rosa*, as shown for example in the Huxley et al. excerpt (newly cited). See, e.g., *Thomson*, supra. See also Cooper, "Biotechnology and the Law", Section 8.05, pages 8-15 to 8-16 (August 2000), Clark, Boardman, Callaghan ("In essence then, a plant patent applicant cannot lose his rights through public description of the new variety so long as he does not make the stock available for propagation by the public.").

The clear wording of 35 U.S.C. 102(b) is "A person shall be entitled to a patent unless - ... (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States...". There is no geographic limitation of the bar under 35 U.S.C. 102(b) to printed publications in this country. There is no requirement that a printed publication that describes the invention be printed or

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enabled in this country. The second clause of 35 U.S.C. 102(b) barring public sale or use in this country is not relevant because as noted above, the current rejection under 35 U.S.C. 102(b) is based on foreign published documents ("printed publications"), as enabled by the admitted availability of the plants outside the United States more than one year prior to the date of domestic filing.

That the claimed plant was not publicly available in the United States more than one year prior to the date of domestic filing is noted but is not relevant to patentability, as there is no geographic component of enablement. For a patent specification to be enabling, there is no requirement that the starting material required to produce the claimed invention must be located in the United States. See, for example, *Ex Parte Rinehart* 10 USPQ2d 1719, 1720 (Bd. Pat. App. & Inter. 1989), where a specification was found to be enabling even though the required biological material was not deposited, but was obtainable from specified locations in the ocean (specifically, only off the coast of Central and South America, as described in U.S. Patent 4,548,814, col. 1, lines 43-60).

Contrary to applicant's arguments, a printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the printed publication, combined with knowledge in the prior art, would have enabled one of ordinary skill in the art to reproduce the claimed plant, and said printed publication was published more than one year prior to the date of application in the United States (*In re LeGrice*, 301, f.2d 929, 133 USPQ 365 (CCPA 1962)). If one skilled in the art could have reproduced the plant from a publicly available source, then the publication describing the plant would have an enabling disclosure.

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See *Ex Parte Thomson*, 24 USPQ-2d, 1618, 1620, (Bd. Pat. App. & Inter. 1992) ("The issue is not whether the [claimed] cultivar Siokora was on public use or sale in the United States but, rather, whether Siokora seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the Siokora cultivar disclosed in the cited publications."). See also MPEP 2121.03.

It has been determined, and explicitly conceded on the record by applicant, that the above referenced publicly available publication discloses the claimed plant variety and that said claimed variety was placed on public sale more than one year prior to the filing date of the subject application for United States Plant Patent.

As such, the published application, combined with the knowledge in the prior art, would have enabled one of ordinary skill in the art to reproduce the claimed plant. Information regarding the claimed variety, in the form of the publication noted above, was readily available to interested persons of ordinary skill in the art.

Contrary to applicant's continuing assertions, the facts in the instant case are not identical to those presented in *LeGrice*. The *LeGrice* decision states "The particular question of law to be here decided is presented on stipulated facts, which, insofar as they relate to the issue, are here quoted from the record..." 133 USPQ at 367. The list of facts that follows does not include the stipulation that the plants sought to be patented were on sale anywhere. Applicant *LeGrice* never stated that the claimed plants were on sale, nor did he provide copies of the catalogue publications (Brief, Appendix B, pages 10-11). It appears that the Board's conclusion that the plant was on sale and in public use in England had no basis in fact. Naturally, the applicant did not

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comment on this conclusion because the Board went on to state that it was irrelevant, i.e. not the basis for the rejection.

The LeGrice Court noted that "...only an 'enabling' publication is effective as a bar to a subsequent patent. We do not agree with the view expressed by the examiner that this necessarily requires that plant publications be 'totally ignored.' " 133 USPQ at 374. The LeGrice Court concluded, "The mere description of the plant is not necessarily an 'enabling' disclosure." 133 USPQ at 378. In the instant application, there is more than a "mere description" of the plant – there is also evidence of public availability of the same more than one year before the instant application was filed. The claimed plant is within the "knowledge of those skilled in the art" by virtue of its public availability. One skilled in the art would thus have known "how to make" the claimed plant upon reading the cited publications, by purchasing a clone of the plant and asexually propagating it by cuttings or any other known method in the art. Thus, the publications provide an enabling disclosure when combined with the knowledge of the skilled artisan.

The examiner again agrees that the publication "by itself" would not enable a person skilled in the art to reproduce the claimed plant. However, the availability of the plant whether through sale or other form of public availability would enable the disclosure of the printed publication.

The contention that foreign commercial availability or public use is not a bar to patentability under 35 U.S.C. 102(b) is noted but is not relevant. The clear wording of 35 U.S.C. 102(b) is "A person shall be entitled to a patent unless - ... (b) the invention



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was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States...". There is no geographic limitation of the bar under 35 U.S.C. 102(b) to printed publications in this country. There is no requirement that a printed publication that describes the invention be printed or enabled in this country. The second clause of 35 U.S.C. 102(b) barring public sale or use in this country is not relevant because as noted above, the current rejection under 35 U.S.C. 102(b) is based on a foreign published document ("printed publication"), as enabled by the admitted availability of the plants outside the United States more than one year prior to the date of domestic filing.

Therefore, a foreign disclosure describing the claimed subject matter, published over a year prior to the filing of the domestic application, is an enabling bar under 35 U.S.C. 102(b) where the plant stock necessary for the publication could have been obtained over a year prior to the domestic filing of an application.

The arguments that the *Thomson* decision is an "ill conceived notion action by the Patent Office administrative tribunal that is unsound from both technical and legal standpoints", that such is not in accordance to the law and is not applicable to the instant application as the *Thomson* application was drawn to a utility patent are noted but are not persuasive. *In re LeGrice*, 35 U.S.C. 161, and 36 CFR 1.161 clearly state that the same laws and rules relating to applications for utility patents also are applicable to plant patents except for the one exception set forth in 35 U.S.C. 162. Such is acknowledged by applicant in the April 7, 2004 response.

2. Applicant is advised of the new mandatory procedures for amending the specification and claim under 37 CFR 1.121. Applicant may review same on the Internet at the following site:

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtprac.htm>

3. Effective May 1, 2003, the USPTO has a new Commissioner for Patents address. Correspondence in patent related matters to organizations reporting to the Commissioner for Patents must now be addressed to:

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

For further information regarding the new address, see Correspondence with the United States Patent and Trademark Office, 68 Fed. Reg. 14332 (March 25, 2003).

4. Any inquiry concerning this communication from the examiner should be directed to Examiner Howard J. Locker whose telephone number is 571-272-0980, and whose normal work hours are Monday through Thursday, from 6:00 a.m. to 4:30 p.m.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Andrew Wang, can be reached at 571-272-0811.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 1600 receptionist whose telephone number is 571-272-1600.

### **TELECOPY/FACSIMILE TRANSMISSION**

Papers related to this application may be submitted to TC 1600 by facsimile transmission. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The official fax number for TC 1600 is: 703-872-9306. The new central fax number for official correspondence is 571-273-8300.

Howard J. Locker/hjl  
May 23, 2005

  
HOWARD J. LOCKER  
EXAMINER  
GROUP ART UNIT *2662*

## **REQUIREMENT FOR INFORMATION UNDER 37 CFR 1.105**

Applicant and the assignee of this application are required under 35 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application. The information is required to determine the accessibility of the foreign sales and the reproducibility of the plants that were sold to the public, more than one year prior to the effective filing date of this application.

The information is required to determine when, and to what extent, the claimed plant variety 'Meinussian', was publicly available prior to the filing date of the instant application.

In response to this requirement, please provide (to the extent not already provided):

(a) a copy of any plant breeder's rights applications, published proposed denominations, and breeder's rights grants, relating to the claimed plant variety;

(b) a copy of any publications or advertisements relating to sales, offers for sale, or public distributions of the claimed plant variety anywhere in the world if the sale, offer for sale, or public distribution occurred more than one year prior to the filing date of this application;

(c) any public information available regarding sales, offers for sale, or public distributions of the claimed plant variety anywhere in the world which occurred more than one year prior to the filing date of this application, including the date(s) and location(s), as well as whether this was an obscure, solitary occurrence that would go unnoticed by those skilled in the art; and

(d) any information relating to the accessibility or non-accessibility of the claimed plant that one of ordinary skill in the art could have derived from the printed PBR document(s).


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The Office does not maintain a collection of Breeders' Rights documents and they are not readily obtainable electronically. It is reasonable to expect that Applicant or the assignee can readily obtain the requested documents and information.

The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in response to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. If an item required by the examiner is unknown to the applicant, a statement that the item is unknown to applicant will be accepted as a complete response to the requirement for that item. Where the applicant does not have and cannot readily obtain an item of required information, a statement that the item cannot readily be obtained will be accepted as a complete response to the requirement for that item.

This requirement is an attachment to the enclosed Office action, and is brought forth subsequent to the CAFC decision in *Elsner* and *Zary*. A Complete reply to the enclosed Office action must include a complete response to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action, which is three (3) months.

  
HOWARD J. LOCKER  
EXAMINER  
GROUP ART UNIT 1661